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TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.

In Re Application Of:
Brad Baker

Serial No.	Filing Date	Examiner	Group Art Unit
09/607,313	June 28, 2000	L. Tran	1761

Invention:

Paint Set Confectionery

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application.

The fee for filing this Appeal Brief is: \$160.00

- ☒ A check in the amount of the fee is enclosed.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **13-4213**
A duplicate copy of this sheet is enclosed.

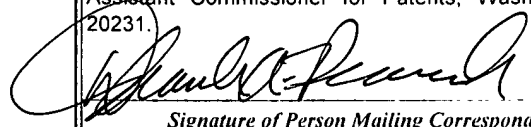

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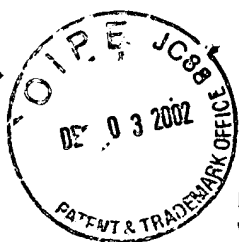
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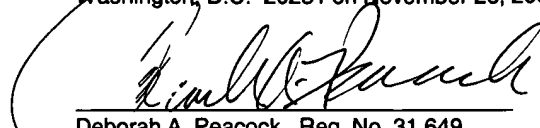
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PATENT APPLICATION

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Deborah A. Peacock, Reg. No. 31,649

November 26, 2002
(Date)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant/Appellant: Brad Baker
Serial No. 09/607,313
Filed: June 28, 2000
For: PAINT SET
CONFECTIONERY

Examiner: L. Tran
Group Art Unit: 1761

Commissioner for Patents
Washington, D.C. 20231
ATTN.: Board of Patent Appeals and Interferences

BRIEF FOR APPELLANTS
UNDER 37 C.F.R. § 1.192

(1) Real Party in Interest

The real party/parties in interest is Impact Confections, Inc. which has been assigned rights to the invention.

(2) Related Appeals and Interferences

There are no other appeals or interferences known to appellant/appellants or appellant's/appellants' legal representatives or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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(3) Status of Claims

Only one claim is pending. Claim 29 stands finally rejected.

(4) Status of Amendments

No amendments subsequent to final rejection have been entered by the Examiner.

(5) Summary of Invention

Referring to Page 5 of the Specification, the present invention relates to a confectionery set. For purposes of the present appeal, the sole claim limits the confectionery set at issue and may be described as follows.

Specifically, reference is made to the embodiment disclosed in FIGS. 1 through 14. As shown, the confectionery set comprises five elements: (1) a paintbrush lollipop; (2) a can; (3) a lid; (4) a flowable confectionery contained in the can; and (5) a brush holder. The paintbrush has a non-edible handle portion and an edible bristle portion, i.e. a candy sucker. The candy sucker and handle in the form of a paintbrush is shown alone in FIGS. 1-3, 6, 9, 11(a)-11(b), 12, 13, and as part of the confectionery set shown in FIG. 14.

The confectionery set also includes a container in the form of a cylindrical can, as shown in FIGS. 4-5, 7-8, 10(a)-10(c), and 14. Specifically, the can **18** has one open end **28** and one closed end at **26**. The can contains contents **24**, such as a powder, fluid and/or flowable confectionery. (Specification, page 9, lines 7-11). The open end **28** defines a rim. The rim includes engagement means for receiving and temporarily holding a lid; the engagement means is shown in detail in FIG. 10 which is a preferred embodiment of the engagement means.

A lid **22** has a can engagement means, as seen in the embodiment shown in FIG. 5, comprising a surface **32** (See FIG. 4) that, as shown in FIG. 10, is press fit into the can engaging the inner surface of the rim **28**.

The fourth element of the confectionery set comprises a flowable confectionery **24** which is described at length at page 16, line 25 through page 18, line 6. The flowable confectionery is contained within the can at the time of sale and during use and is extractable by wetting the sucker **14** (paintbrush bristles) and dipping that paintbrush edible portion into the confectionery which adheres to the brush bristles and which may be licked or sucked by the person consuming the edible portion of the product.

The fifth element of the invention comprises a paintbrush holder which is described at page 11 of the Specification with reference to FIG. 14 as follows:

FIGS. 14(a) and 14(b) show illustrations of a brush 10 and a can 18. The brush 10 and can 18 are connectable through packaging 78 such as, but not limited to, shrink wrap, adhesive or other packaging as shown in FIG. 14(c) which comprises a finite length cylinder 80 connected to a finite length hollow tube section having a substantially rectangular cross-section 82. The packaging 78, as shown in FIG. 14(c), cooperatively receives can 18 and brush 10.

Id. at lines 17-21. As seen in FIG. 14, in the two lower views, the brush 10 is received and vertically positioned within the hollow tube with the rectangular cross-section 82. The tube 82 is referred to as a brush holder in the claims.

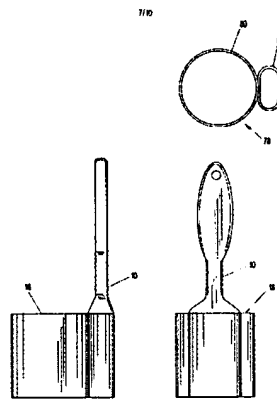


FIG-14

(6) Issues

- (i) Whether Claim 29 is unpatentable under 35 U.S.C. § 103(a) over a product described in a brochure, referred to as Paint Pop, in view of Kern and Gramlich; and
- (ii) Whether Claim 29 is indefinite for failing to comply with 35 U.S.C. § 112.

(7) Grouping of Claims

Not applicable.

(8) Argument

The claim is rejected under 35 U.S.C. § 103 based on a brochure referred to in the prosecution as the "Paint Pop" product in view of U.S. Patent Nos. 5,960,646 ("Gramlich") and 4,547,926 ("Kern"). The indefiniteness rejection is based on a lack of disclosure of the paintbrush holder as recited in element 5 of Claim 29.

The Paint Pop brochure shows:



Before addressing the specific arguments of the Examiner, it is pointed out that the confectionery set of the sole claim asserted, Claim 29, is a novelty candy item which obtains its consumer appeal from a simulation of a paintbrush and paint can. The choice of a paint brush and paint can is particularly apropos since consumption of the product requires the user to "dip" the paintbrush into the paint can (containing the flowable confectionery) and then to "paint" the user's tongue with the flowable confectionery. The novelty stems from the analogy to the actual products--paintbrush and paint can--and the method of "painting". The prior art Paint Pop product is also a novelty candy product and is thus relevant to the patentability question of Claim 29. It too relies upon an analogy between a confectionery set comprising a paint roller, tray, and a flowable confectionery and an actual product used for painting large surfaces.

The Examiner has admitted since the first Office Action (May 8, 2001) that the Paint Pop brochure does not disclose a paint can or a paintbrush. (*Id.* at p. 3). (The first two paragraphs on page 3 are somewhat confusing in that the Examiner has mixed up the "can" and the "tray" but subsequent Office Actions show that the Paint Pop product has a roller and tray, whereas Applicant's product comprises a brush and can). Despite these obvious structural differences between the claimed subject matter and the Paint Pop brochure, in the Second Office Action (Paper No. 9, July 20, 2001) the Examiner further articulated her basis for finding obviousness notwithstanding the structural differences as follows:

"The Paint Pop product displays a similar concept as the claimed product which is to make a product that simulate[s] a paint set which contains edible product. . . Applicant's claimed product has the same concept; the two products differ only in the shape."

Id. at p. 2. (Emphasis added).

It is fundamental to the Examiner's obviousness objection that: (1) if a novelty candy product simulates a "real" product; and (2) the prior art discloses a candy novelty product selected from the same genre of real products; then (3) the particular structure of the elements recited in the claim cannot be patentable because the only difference is one of "shape". Applicant submits that this is an improper Section 103 objection because the structural differences between the prior art and claimed invention have important functional consequences that the Examiner has not properly considered.

Applicant submits that the Examiner's rejection may be summarized as having six arguments:

1. A "mere" change in shape.
2. The lid element in the claim, not included in the Paint Pop brochure, may be supplied from a real paint roller/tray, i.e. not from another novelty candy product.
3. There is no disclosure of a brush holder, element 5 of the claim (the Section 112 rejection and part of the Section 103 rejection).
4. Similarity of concept is, without regard to structure or function, sufficient on which to base a rejection of obviousness.
5. Containment of the flowable confectionery at the time of sale and use is structurally but not functionally different.
6. The secondary considerations fail for lack of sufficient proof.

Each of these arguments will be addressed separately.

The first five arguments relate to the primary test of obviousness under Section 103 and the Section 112 rejection. These are each addressed in Section A. The Section 112 rejection is specifically addressed in Section A.1. The secondary factors rejection is addressed in Section B.

A. The Section 112 Rejection is Improper and the Section 103 Rejection Based on the Prior Art Is Also Improper

1. No "Paint Brush Holder" Is Shown In The Prior Art

The fifth element in Claim 29 recites: "a paint brush holder attached to said container".

The Examiner first addressed the holder in the first Office Action (May 8, 2001) where she simply stated "it would also have been obvious ... to include a holder as a variation to enhance the playful nature of the product." (Page 4). In the Office Action dated July 20, 2001 the Examiner noted Applicant's argument with respect to the holder and stated:

"Applicant further argues the Examiner did not address the packaging. The Paint Pop product as shown in the picture is a package comprising the tray, powder and the paint roller. The roller and the powder are in the tray and is [sic] not completely separable from the Paint Pop tray. When the Paint Pop product is put on the market, it would have been obvious to package the product to facilitate the selling of the product to consumers because the tray, the paint roller and powder all go together and they would not be sold separately."

(Page 3). In the May 30, 2002 Amendment, Applicant cancelled the two existing claims and introduced Claim 29. Claim 29 specifically defined "a paintbrush holder attached to said container." In the final rejection (Office Action dated August 2, 2002) the Examiner raised a Section 112 rejection denying that the specification showed a paintbrush holder:

"Claim 29 recites the limitation 'a paint brush holder attached to said container'; this limitation is not supported by the original disclosure and the drawings. The drawings do not show a paint brush holder attached to the container. The paintbrush is attached to the container by packaging; Page 11 of the Specification discloses 'the brush and can are connectable through packaging such as shrink wrap, adhesive or other packaging'. There is no disclosure or showing of a separate 'paint brush holder attached to the container'."

(Page 2). Then, the Examiner argued that the failure to disclose undermined applicant's Section 103 argument:

"Lastly, Applicant argues there is no disclosure of the holder for a paintbrush which is attached to the container. The tray has a depression is [sic] which the roller is placed as shown in the picture; this is equivalent to the holder because it is not known what the claimed holder is. There is no disclosure of a separate holder or a showing of a separate holder in

the Specification. The Specification discloses the brush and can are connected through packaging.

(Page 4).

It is submitted that the Examiner is clearly in error on this issue and such error is dispositive of both rejections. First, the Examiner is in error as to the disclosure of a paintbrush holder in the specification. The Examiner truncated the sentence on Page 11 of the Specification by ending his quotation after the word "packaging" whereas the sentence as indicated above is completed by stating: ". . . as shown in FIG. 14(c), which comprises a finite length cylinder **80** connected to a finite length hollow tube section having a substantially rectangular cross-section **82**." The next sentence states that the packaging **78** as shown in FIG. 14(c) "cooperatively receives can **18** and brush **10**." (emphasis added). The Examiner ignored the remainder of the sentence which points to a figure that unequivocally discloses a paintbrush holder. Moreover, even without the textual material, it is obvious from FIG. 14 (the figures as submitted are not labeled as "14(a)", "14(b)", and "14(c)" but it is obvious from the simplicity of the figures that the specification is referring to the plan view as FIG. 14(c) where the hollow tube having a substantially rectangular cross-section **82** is best shown) that the specification discloses a tube **82** that receives and holds the paintbrush. The sentence refers to three types of packaging: shrink wrap, adhesive or "other packaging as shown in FIG. 14c, which comprises a finite length cylinder **80** connected to a finite length hollow tube section . . ." The Examiner is flatly wrong in the statement that there is no disclosure or showing of a paintbrush holder attached to the container. That is precisely what is shown in FIG. 14. The Section 112 rejection should be reversed.

Without admitting that the paintbrush holder is properly disclosed, the Examiner attempts to argue that the tray has a "depression" in which the roller is placed and this is the equivalent of a holder "because it is not known what the claimed holder is". (Page 4). The Examiner then recites the same error by stating: "There is no disclosure of a separate holder or a showing of a separate holder in the specification." That statement is clearly erroneous as shown above. To the extent that the Examiner is arguing that even if there is a holder disclosed in the application that the prior art tray has a "depression" that is the equivalent of the claimed holder the argument is far-fetched. Even assuming that the tray is the "equivalent" of the can (which Applicant denies as discussed below), it is obvious that the depression is not the "equivalent" of the paintbrush holder **82**. The holder **82** is attached to, not a depression within, the container shown in FIG. 14. Nor is there a

suggestion in the Paint Pop brochure that when sold the roller fits into the depression at the end of the tray where the flowable confectionery is poured as shown in FIG 1. on the brochure.

Because the prior art is entirely lacking in a showing of a positively claimed element having a clear functional purpose the Examiner's Section 103 rejection is in error and should be reversed.

2. Change in Shape

As noted above, the Examiner maintains that the structural configuration of all of the elements in the confectionery set of Claim 29 are merely a selection of shapes to "enhance the playful purpose of the product", including the container (First Office Action dated May 8, 2001, Page 3). In the Second Office Action dated July 20, 2001 the Examiner stated:

"Applicant's claimed product has the same concept; the two products differ only in the shape. However, Applicant is only moving from one conventional shape to another conventional design shape. A paint tray, a paint can, a paintbrush and a pain [sic] roller are all conventional shapes. To change from one conventional shape to another conventional shape would have been obvious to one skilled in the art."

(Page 2). In the Office Action of January 30, 2002 the Examiner reiterated the "shape" rejection using nearly the identical language. (Page 2). Finally, in the Final Rejection dated August 2, 2002 the Examiner for the first time addressed Applicant's repeated argument that to demean the invention because it is merely of a different shape is not proper if it is shown by Applicant that the difference in shape provides a difference in function and that such function is not disclosed in the prior art. The Examiner stated:

"3. In the Response filed May 30, 2002, applicant argues it is evident that shape of a product may affect function and distinguish prior art. Applicant has not set forth how the different shapes in the instant case affect function. Whether the candy is in the shape of a paintbrush or the shape of a paint roll, it still has the same function of being the edible portion of the product."

(Page 2). The Examiner went on to state: "One of skill in the art is readily aware that both paint can/brush and paint tray/roller are conventional shapes and the adaptation of the candy to either conventional shapes would have been an obvious variation; this is a variation of design choice with no alteration in function." (Page 3). The Examiner then went on to state the reason why she believed that the differences in shape are irrelevant:

"Applicant's argument would have been persuasive if there is no teaching of any lollipop product which simulates actual paint product; in the instant case, the Paint Pop product is a teaching of a candy product which simulates actual paint product. The question is whether or not it would have been obvious to move from one conventional paint product shape to another conventional shape and the answer is yes because both paint can/brush and paint tray/roller are well known shapes for paint products. The substitution of one shape for another depends on the design desired and would have been obvious to one skilled in the art."

(Page 3).

Thus, the Examiner's reasoning, as understood, is that with respect to patentability of novelty candies, if one product is a simulation of a real product, then a later product selected from that same actual product genre is unpatentable regardless of whether a structural shape change provides a new function in the later product. Applicant submits that this is a misstatement of the law. Under Section 103 there must be some suggestion for modifying a prior art reference to meet the claimed invention. The Examiner's apparent position is that because both products, the claimed subject matter and the prior art, are simulations of real products from the same class, category, or collection of products, no suggestion is required.

On the other hand, the Examiner appears to also argue that Applicant has failed to factually establish that there are functional differences to the claimed shape. That requires a consideration of all of the elements of the claimed combination. It is superficial to simply state that the function of both products are the same because they are both "edible". To determine if the differences in shape are functionally important, each element of the combination must be separately considered.

3. The Lid in the Claim Combination Is Not Shown in the Prior Art Primary Reference: Reliance Upon the Secondary References to Show a Lid Is Improper

Claim 29 recites "a lid having can engagement means for mating with said lid engagement means to form a seal between said lid and can at least at the time of sale of the confectionery set".

In the first Office Action (May 8, 2001), the Examiner in reference to the prior art Paint Pop product simply stated that "[i]t would also have been obvious to include a lid so that the

product will not fall out...." (Page 4). In the Second Office Action of July 20, 2001 the Examiner stated with respect to the lid:

"As to the inclusion of a lid, it would have been obvious to include a lid to prevent the product from falling out and to keep material in the tray clean; this is a notoriously well known concept. For example, when food is kept in a container, it is common to put a lid on the container to keep the food clean and to keep it from falling out. With paint tray, it would have been obvious to put a lid to prevent the paint from falling out. Putting a lid on a container is a common practice which would have been readily apparent to one skilled in the art."

(Pages 2-3). That action was made final by the Examiner and Applicant submitted an amendment dated August 17, 2001 under 37 C.F.R. § 1.116(a).

In response, the Examiner decided that the lack of any showing of a lid in the Paint Pop product could be solved by finding a prior art reference of an actual paint product that disclosed a roller and paint tray with a lid provided for the paint tray. The Examiner relied upon the Gramlich and Kern references for this teaching. The Examiner therefore withdrew the final rejection and issued an additional Office Action dated January 30, 2002 where it was argued that "...it would have been obvious to one skilled in the art to also adopt the teaching of Gramlich and Kern to provide a parallel function to a painter." In the final rejection Office Action (August 2, 2002) the Examiner explained the reason for citing an additional reference as follows: "There was of course no suggestion in the Paint Pop product to add a lid." Indeed, the Paint Pop product taught away from a lid, i.e. the flowable confectionery was contained in a separate packet, as explained below. In other words, there was no need for a lid in the Paint Pop product.

In fact, the Examiner has completely mixed up the structural elements and functions of the claimed subject matter and the Paint Pop product. The Examiner states that the Paint Pop product inherently has shrink wrap to prevent the roller and packet of confectionery from falling out and that this is "equivalent" to a lid. However, the Examiner is entirely confused. The shrink wrap in the Paint Pop product is packaging which as the Examiner correctly notes, holds the roller, packet, and tray together. But as Applicant argued at length, the lid does not "hold the product together" but indeed is a container for the flowable confectionery product. The function of the lid in Applicant's product is to contain the flowable confectionery within the second element--the can--into which the paintbrush edible portion may be dipped. By contrast, the Paint Pop product provides a different "container", namely, a cellophane packet (called a "sachet") that contains the

flowable confectionery. Thus, the function performed by the sachet in the Paint Pop is to contain the flowable confectionery at the time of sale. But the roller is not dipped into the sachet during consumption, it is dipped into the tray after the powder is emptied from the sachet into the tray. In other words, it could be argued that the sachet performs the function of Applicant's can and lid in combination, i.e. it protects the contents before sale.

Even if a lid is placed on the tray of the Paint Pop product, it does not contain the flowable confectionery which is contained within the sachet. In short, there is no equivalency between the shrink wrap packaging of the Paint Pop product and the lid. To be "equivalent" Applicant's claimed product would have to be a can or container larger enough to enclose the paintbrush and separately within the container another package that encloses the flowable confectionery. Clearly, that is not Applicant's claimed product. Stated conversely, for the Paint Pop product to be equivalent to that of Applicant's product, the paint tray (the arguable equivalent of the can) would have to contain the powdered candy at the time of sale (which would not be in a sachet) and the paint roller would have to be exterior of the tray and lid and somehow attached to the tray with a holder.

Moreover, the Examiner refused to concede that there were functional differences and advantages in the manner in which the elements of the claimed subject matter are combined. Specifically:

1. Claim 29 clearly recites that the lid that encloses the container forms the seal "at least at the time of sale of the confectionery set". The purpose of this temporal limitation is to make clear that the function served by the lid is to close the container so that the product can be shipped from the manufacturer through the various distribution levels to the retailer and arrive to the customer with the lid intact and the flowable confectionery uncontaminated, free of environmental changes, and without loss of contents that may have been encountered from the point of manufacture to that of sale. Even putting a lid on the tray would not meet the claim because the tray is not a can, it would not prevent contamination or loss of the flowable confectionery because that function is supplied by the sachet. The Paint Pop product was designed to achieve the same "protection" function as deemed desirable in applicant's product--but it used an entirely different structure--a sachet, separate from the tray.

2. Of equal importance is the function served by the lid during consumption of the product. It is unlikely that a child will consume the entire contents of the flowable confectionery when it is initially opened. Thus, during some period in which the confectionery is not being

consumed, the lid serves the salutary function of enclosing the flowable confectionery, which is easily spilled, in the can. This serves to prevent inadvertent spilling of the confectionery out of the can as might be expected considering that the product is being consumed by a child, not by a careful adult.

3. Moreover, by enclosing the can during a break in the consumption it will prevent the possibility of ants or flies or other insects consuming the confectionery and possibly despoiling the product. Again it is pointed out that the product is being consumed by a child and not by an adult who is likely to take care to see that insects do not invade the product between periods of consumption. The Examiner condescendingly states that it would be "common sense" to cover the tray of the prior art product with a lid. Common sense to whom? It was not common sense to the designer of the look-alike product called "Roller Pop". (Moskowitz Declaration, supra, p. 16) It is the convenience of a lid that is tight-fitting and is part of the product that makes the product more hygienic notwithstanding any adverse conditions in which it is consumed by a child.

4. It is also cheaper to place the flowable confectionery into the can as opposed to the sachet as in the prior art product. The Examiner states that there is no proof that it is cheaper. But to echo the Examiner, it is only common sense that if a cellophane bag or sachet is not required in one product, and is required in another, the latter will be more expensive even if it is only fractions of a penny. Additionally, not only is there the material costs, but of course, the labor which would likely add up to more than a few pennies.

The Examiner has not addressed the reasons given above that establish that the function performed by the lid in Claim 29 is not equivalent in the combination of references including Paint Pop and Kern and/or Gramlich. The Examiner states that the lid in the real product will preserve the contents and prevent the contents from drying out and spilling. He then states: "Thus, there are ample reasons to include a lid in the Paint Pop product." But that of course is not the test. There are always reasons for configuring a product as claimed. But the mere existence of those reasons, unrecognized by others, does not make it obvious to others to solve the problem in the way in which the problem is solved by the claimed subject matter.

In any event, the Examiner is wrong as to whether there are reasons to put a lid on the tray. Overlooked by the Examiner is the fact that at the time of sale, that is from the point of manufacture to purchase by the consumer, there is no lid required on the Paint Pop product because the confectionery is contained within the sachet. There would therefore not be a reason

to use a lid to preserve the contents and prevent the contents from drying out and spilling since that function is performed by the cellophane package without the aid of a "lid". Indeed it may be argued that the Paint Pop product by choosing a container (sachet) separate from the container (tray) used during consumption for containing the flowable confectionery teaches away from the use of a paint tray with a lid. Even analogizing to actual paint products, the Examiner has not had the temerity to suggest that paint might be sold in a paint tray with a lid which would be the equivalent of the elements of the claim.

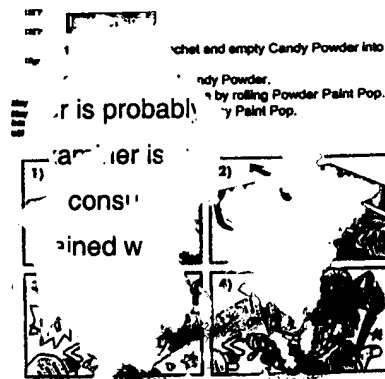
Nor is it immediately apparent how the lid could be made to work with the paint tray of the Paint Pop product. While the Kern and Gramlich references teach the use of a lid with a structural paint tray it is apparent from the picture of the Paint Pop product that the paint tray is a lightweight plastic with very little structural strength. And the lid of the paint tray could hardly be argued as being engagement means for the lid as recited in the claim.

Thus, there are both functional and structural reasons why the Paint Pop product alone, or in combination with Gramlich and/or Kern, does not render obvious the patented combination.

5. The Packet of the Paint Pop Product Has Been Eliminated.

Claim 29 clearly recites the location of the flowable confectionery as follows: "a flowable confectionery disposed within the lid-enclosed container at the time of sale of the confectionery set and extractable by wetting and dipping said paintbrush edible portion in said confectionery".

The claim makes clear that the flowable confectionery is within the container with the lid closed at the time of sale and is later extractable by dipping the wetted sucker into the confectionery when the lid is removed. It is clear from the Paint Pop product that at the time of sale the flowable confectionery is contained within a separate packet or "sachet" that is included within the shrink wrapped total package. In order to gain access to the flowable confectionery, once the shrink wrap has been removed, the instructions state:



In what is submitted as a specious argument of the Examiner, she contends that this element of the claim is met because the candy powder in the sachet in the Paint Pop product is contained, at the time of sale, within the heat shrink wrapped package that includes the roller, sachet, and paint tray. The Examiner states: "Even though the powder is contained in a separate packet, it is also contained in the tray because the packet is in the tray." (Office Action dated August 2, 2002, Page 4). The Examiner also stated in the Office Action dated July 20, 2001:

"The powder in the Paint Pop product is put into the tray; thus, the tray essentially contains the confection. Applicant's claim does not exclude the powder package." (Page 3).

It is true that the claim does not include a negative limitation as to what it excludes, but then that is not understood to be the function of a properly drafted claim. It excludes by virtue of the fact that it does not positively recite a packet as the container for the confectionery powder, simply because the packet is unnecessary where the confectionery is contained directly within the lid-enclosed can at the time of sale.

As noted above, the use of a lid eliminates the need for a separate package for the flowable confectionery. Applicant argued that that would make the cost of the product less expensive to manufacture. Yet the Examiner came back and stated that Applicant did not show that it "is cheaper for the flowable confectionery to be contained in a can with a removable lid" as opposed to a separate packet. As pointed out above, Applicant does not believe it is necessary to prove that if you eliminate a component from a product, it is less expensive to manufacture. While that may not always be true, it is certainly a logical conclusion to draw. The point hardly requires Applicant to come forward with detailed proof of the cost of Applicant's product, which involves innumerable variables (quantity, pricing points, availability, and a myriad of other factors involved in costing a product) and then comparing that with a hypothetical Paint Pop product or being required to obtain costs on the product from the Hungarian manufacturer. Similarly, the Examiner asks, perhaps rhetorically, why the container with the lid would be more hygienic than the sachet. Again, the Examiner appears to forget that this is a product that is intended for use by children. It may very well be that a chemist or a lab technician with skills in carefully handling products such as cutting open a cellophane package and depositing the contents into a container could open a cellophane package without spilling the contents. But this product is for a child. It is more likely that the child will spill some of the flowable confectionery in the process of opening the package or in pouring it into the tray. It is not likely that the child will simply discard the spilled material but will attempt to recover it by scraping it up and putting it into the container. It is much easier to open a

can than it is a sealed packet. And once the can is opened, it need not be deposited into another container into which the sucker may be dipped. That is why it is more hygienic to have the powder in the can, rather than in a packet.

With respect to whether or not the product is more or less expensive with a separate sachet, or is more or less hygienic than packaging the powder in the sachet, logic, common sense, and knowledge of the manner in which children consume confections, known to any adult who is a parent, is adequate proof as to the advantages of Applicant's product configuration.

In summary, there are not merely differences in structure between the prior art and Applicant's claimed subject matter. The differences in functions performed by the elements in Claim 29 compared to what is shown in the prior art (a brush holder is not shown) clearly establishes the differences between the prior art and the claimed subject matter as required under the John Deere test, as acknowledged by the Examiner as the appropriate Section 103 interpretation. Applicant's claim is very clear, very specific, and is different from the prior art. On this basis it is respectfully submitted that the rejection should be reversed and Claim 29 should be allowed.

B. Consideration of Secondary Factors

In addition to the arguments set forth above establishing the primary factors affecting patentability under Section 103, Applicant also offered three declarations in support of the "secondary considerations" recognized in John Deere and many later cases. There are three declarations and each will be separately discussed.

1. Baker Declaration.

Mr. Brad Baker is the President of the assignee, Impact Confections, Inc. and has been in that position for twenty-one (21) years. He states that he personally oversees product development in the company and is the inventor of the subject matter in this application. Mr. Baker's experience in the industry places him in a position to offer opinion testimony with respect to product development and product marketing. Mr. Baker explained that in a period of three (3) years, the commercial embodiment of the subject matter of the Application accumulated sales of Fifty Million Dollars (\$50,000,000.) As a comparative basis, Mr. Baker states that it is the most successful product in the history of the company. That is one comparative basis for his opinion that the product is a commercial success. Mr. Baker also states that in his position as President of the company, he attends tradeshow, visits customers, and stays abreast of competitor

activities. Again, based on the solid foundation of his background in the industry he gives his opinion that Applicant's invention is a highly successful product compared to his competitor's products.

The Examiner states that "[a] sales figure does not demonstrate commercial success." (Office Action, Page 5). There is no support in MPEP § 716.03 (August 2001) for this broad statement; and it clearly does not require that Applicant show that sales results stem "solely" from the product. The Examiner is confusing "solely" with the requirement that the Applicant must show a nexus between the claimed invention and evidence of commercial success, such as a high rate of growth of a product over a three-year period. Section 716.03(b), at 700-226, states that sales figures alone do not prove commercial success absent evidence of market share, or as to the time period during which the product was sold, or as to what sales would normally be expected in the market. The latter two questions are answered in the Declaration of Mr. Baker; the former, as discussed below, is in the Declaration of Mr. Taylor. Mr. Baker points out that sales have gone from zero dollars to \$50,000,000 in a period of approximately three (3) years. There is a definite time period related to the sales. As to what sales would normally be expected in the market, Mr. Baker offered his expert opinion that the product has sold better than other Impact products and that he has compared it with other products sold by his competitors and has determined that it is successful from that benchmark. The Examiner states that "... it is not known what this sales figure means." (Office Action dated August 2, 2002, Page 5). It is difficult to understand what the Examiner finds puzzling about this sales figure.

Mr. Baker also testified to the fact that the industry gave recognition to the Impact Confections' (Applicant's) product by giving it the Product of the Year Award for 1999 in the novelty category. The Examiner retorts: "How does this award relate to commercial success?" (Id.) As Applicant explained in the Amendment of May 30, 2002, industry recognition if not evidence of commercial success is evidence that professionals in the field found merit in the patented subject matter. (Page 10). Perhaps this evidence is more indicative of a long-felt need, since recognition by others in the field of the merit of a product infers that other efforts to create novelty products in the candy field did not achieve the excellence achieved by Mr. Baker. The Examiner has never rebutted the statement in the identified Amendment, but rather states that it is an opinion not backed up by any evidence. That is untrue. Mr. Baker gave his opinion based on the sales over a finite period that show a highly successful growth rate and his factual observations as to comparisons of the claimed product and other Impact products, and other competitor's products. considerations cannot establish unobviousness in and of itself.

Considered with the arguments set forth above, it is submitted that there is commercial success that is further weight on the side of the scale in favor of unobviousness.

2. Moskowitz Declaration.

Mr. Moskowitz currently works for the assignee, Impact Confections, Inc., and was previously employed by a company that manufactured and sold a product known as Roller Pop which is similar to and sold prior to the Paint Pop product. The Roller Pop product includes a tray, paint roller, and a packet of powdered candy. Photographic reproductions of the product packaging are attached to Mr. Moskowitz' Declaration.



Mr. Moskowitz characterized the success of the Roller Pop product as "mild". Moreover, such mild success was only for a limited period of time. The Examiner ignores that part of Mr. Moskowitz' Declaration (Office Action dated August 2, 2002, Pages 5-6), although it is precisely the information which in the prior Office Action the Examiner challenged with respect to commercial success. The Examiner maintained that there must be some reference for the sales figures. Mr. Moskowitz provides a direct reference between that product which is almost identical to the prior art relied upon by the Examiner and the subject matter of Claim 29. One is a mild success, the other is a raging success. There is no question that Mr. Moskowitz has the foundation for opining with respect to the success of the Roller Pop product. Thus, the evidence is clearly and favorably to the effect that the Claim 29 product is a commercial success.

Mr. Moskowitz also gave the reasons why he believed that the Roller Pop product was not successful. Mr. Moskowitz points out that the sucker "roller" on the roller assembly including the handle was difficult to lick. The Examiner states that this statement is not backed up by evidence. The Examiner suggests that evidence would constitute testing of the two products on different populations. (*Id.*, Page 5). The Examiner then goes on to argue with Mr. Moskowitz, whose qualifications as a marketing and product development person of ordinary skill in the art are unquestioned by the Examiner. The Examiner, it is submitted, is not qualified to argue with the testimony set forth by a person who has clearly superior qualifications for rendering the opinion

with respect to how a product works. The Examiner is wrong in the suggestion that no expert testimony is satisfactory evidence without conducting a survey. The Examiner may question the expert's opinion and accord it little weight. But the Examiner cannot simply state that there is no evidence backing up an expert opinion and dismissing the opinion in its entirety.

Mr. Moskowitz points out the problems in the Roller Pop product that in his opinion were attributable to the lack of success in the marketplace. The Examiner then takes these problems and states that they provide the "motivation" to create Applicant's claimed subject matter. The Examiner has it backwards. Mr. Moskowitz explains that these problems existed when the product was introduced in 1993 or 1994. Yet neither he as the inventor and product developer nor his employer solved the problems by "merely" changing the shape, that is, creating Applicant's confectionery set as set forth in the Claim 29. Mr. Moskowitz' testimony is evidence that the solution in the claimed subject matter was not obvious; otherwise, he would have solved the problems that he described with respect to the Roller Pop product. Put another way, if these problems provided "motivation" as the Examiner suggests, it did not motivate Mr. Moskowitz nor his employer to create a product like the claimed subject matter which, having solved the problems, became a success in the marketplace.

3. Taylor Declaration.

The Taylor Declaration was submitted by Applicant also to establish commercial success. Mr. Taylor is a consultant in the candy industry and was asked to provide an opinion with respect to the commercial success of the Applicant's invention subject matter in the marketplace. As indicated by his resumé he has a high level of experience in the candy industry. He has also had direct experience in developing novelty candy products. In order to show the growth of the subject matter of Claim 29 in the marketplace, Mr. Taylor states that its sales increased by one hundred fifty percent (150%) in the year 2000 and thirty percent (30%) in 2001. He compares that to growth in total confectionery sales from 1999 to 2001 of approximately twelve and one-half percent (12.5%). This is the basis for the claim of commercial success, complete with a comparison to other candy products with which the claimed product competes. (Taylor Declaration, ¶¶ 4-5).

From another point of view, Mr. Taylor testifies with respect to candy sales in the fifty-two (52) week period immediately preceding August 2001. Sales during that period of the claimed subject matter were more than Twelve Million Dollars (\$12,000,000) which made it rank twelfth out

of six hundred twenty (620) novelty/hard candy items included in the ranking. The Examiner ignores such evidence.

Mr. Taylor also testifies that the success of a candy product is evidenced by the extent of distribution through various classes of trade. He then goes on to point out the extensive distribution channel of the product that is the subject of Claim 29. The Examiner simply controverts Mr. Taylor's testimony stating that many places of distribution of the product "does not mean commercial success". From what basis of expertise does the Examiner challenge the testimony of Mr. Taylor? Again, it is improper for the Examiner to simply argue with an expert in the industry. It is within the Examiner's purview to assign less weight to an argument if it is not convincing to the Examiner, but the Examiner cannot simply dismiss such statements by a counter-statement which is unsupported by any qualifications or foundation.

C. Summary of Argument.

Claim 29 has been improperly rejected. It specifically sets forth five (5) elements that comprise the combination of the confectionery set. The prior art does not show:

- (1) a paintbrush comprising an inedible handle and edible bristles (a sucker);
- (2) a can containing a flowable confectionery;
- (3) a lid that is fitted to the can so as to contain the confectionery at the time of sale and at some point during consumption; and
- (4) a holder for the brush.

No argument of the Examiner with respect to similarity of concept can render these elements unpatentable based on the Paint Pop reference, alone or in combination with Gramlich and Kern, which show a paint roller and paint tray with a flowable confectionery contained in a cellophane package. The Examiner implicitly recognizes these structural distinctions and cannot overcome these by an argument that they are both products simulated from a common class of real products and are therefore merely changes of conventional shape.

More importantly, Applicant has not merely pointed out structural distinctions which have been acknowledged by the Examiner but has pointed out the functional differences as well as the advantages of the structural configuration of the confectionery set of Claim 29. In attempting to match the elements of the Paint Pop product to that of Claim 29 the Examiner became understandably confused because there is no matching. There is no brush holder and that alone, on a structural and functional basis, distinguishes the confectionery of Claim 29 from the prior art.

Second, the means for containing the confectionery product at the time of sale is both functionally and structurally distinct--a can with a lid versus a packet or sachet. Third, adding a lid from a secondary reference to the Paint Pop product does not yield components that are comparable to the can and lid. Nor can the Examiner properly state that the shrink wrap that includes all of the components of the Paint Pop product is the equivalent of a lid in Applicant's product for the simple reason that the paintbrush is not within the can.

Assuming that the question of non-obviousness was close, which it is respectfully submitted it is not, the secondary evidence offered by Applicant should tip the scale in favor of Applicant on the question of patentability.

Finally, the Examiner is factually in error as to the disclosure of a paintbrush holder and the Section 112 rejection should be reversed.

(9) Conclusion

The rejected claims are not indefinite and are patentable over the prior art. Reversal of the Examiner's rejections is respectfully requested.

(10) Appendix (Attached).

Respectfully submitted,

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APPENDIX

29. A confectionery set comprising

a paint brush having a non-edible handle portion and an edible
bristle portion;

a container in the form of a cylindrical can with a rim surrounding a
top opening, said rim including lid engagement means for securing a lid on said
container so as to close the container;

a lid having can engagement means for mating with said lid
engagement means to form a seal between said lid and can at least at the time of sale of
the confectionery set;

a flowable confectionery disposed within the lid-enclosed
container at the time of sale of the confectionery set and extractable by wetting and
dipping said paint brush edible portion in said confectionery; and

a paint brush holder attached to said container.